Application No.: 10/615,491 Attorney Docket No.: BRONNE00600

AMENDMENTS TO THE DRAWINGS

The attached sheet(s) of drawings includes changes to Fig. 7A. This sheet, which includes Figs. 7A-7D, replaces the original sheet including Fig. 7A-7D.

Attachment: Replacement Sheet

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REMARKS

Claims 1-43 were pending in the present application. Claims 24-43 were withdrawn from consideration.

Concerning the Drawings

Figure 7A has been amended to correct a typographical error in the figure label. The figure label has been amended from "Fig. 3A" to --Fig. 7A--.

Rejections under 35 U.S.C. §102(b)

Claims 1, 2, and 4 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Persson (U.S. Patent No. 4,622,968).

Applicant respectfully disagrees. The claims at issue teach a method for treating a lung comprising fluidly connecting the lung with an extrapleural airway such that air may pass directly from the lung to the extrapleural airway. Applicant notes that, in paragraph [0041] of the application as filed, "extrapleural airway" it is defined as any airway or portion of an airway that is outside of the pleura such as, for example, the trachea or mainstem bronchus. Persson does not teach or suggest connecting the lung with an extrapleural airway but instead connecting an extrapleural airway (the trachea) to the outside of the patient's body (for example the neck).

Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 1. In addition, applicant disagrees with the rejections of claim 2 and 4, but since Perrson fails to anticipate claim 1, Perrson also fails to anticipate claims 2 and 4.

Double Patenting - I

The Office Action rejected claims 1-23 over various claims in US Patents 6,488,673. Applicant notes that at the end of December, 2003, Broncus Technologies, Inc. formed a separate entity, Asthmatx, Inc. using certain assets related to Broncus' asthma related procedures and devices. The '673 patent was assigned to Asthmatx Inc. and is no longer assigned to Broncus.

Applicant notes that (as stated in MPEP §804) a double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Claims 1-23 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-74 of U.S. Patent No. 6,692,494 (Applicant assumes the Examiner mistakenly switched the claims of the two cited patents).

Applicant respectfully disagrees. The present invention teaches a method for treating a lung comprising fluidly connecting the lung with an extrapleural airway. Claim 1 of U.S. Patent No. 6,692,494 recites a method of improving gaseous flow within a diseased lung comprising the step of altering the gaseous flow paths within the lung by advancing a device into a respiratory opening to create at least one collateral channel in the lung as an additional flow path.

Applicant disagrees that the Office Action establishes a proper prima facie case of obviousness by asserting that because both groups of claims involve creation of channels in the lungs they are not patentably distinct. Applicant request clarification as to why one would modify the claims of the '494 patent to arrive at the claims of the subject invention.

Claim 72 (the only other independent claim in the '494 patent) recites a method of improving gaseous flow within a diseased lung comprising: altering the gaseous flow paths within the lung; locating at least one region within a portion of a natural airway of the respiratory system for altering gaseous flow where locating includes: (a) examining the lung using an imaging method selected from radiography, computer tomography, ultrasound, Doppler, MRI, PET and acoustic imaging to determine a location to alter the gaseous flow, and (b) examining the lung using the non-invasive imaging method selected from radiography, computer tomography, ultrasound, doppler, MRI, PET and acoustic imaging to determine a number of collateral channels to be created.

Applicant believes that claim 72 is clearly patentably distinct from the subject claims. Again, applicant notes that the Office Action fails to establish a proper prima facie case of obviousness with respect to this rejection. Namely, claim 72 does not teach all of the requirements of claim 1 of the subject claims and the Office Action fails to provide any suggestion as to why one would modify claim 72 of the '494 patent to arrive at claims 1,2 or 4 of the pending application.

Double Patenting - II

Claims 1-23 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,488,673.

Applicant respectfully disagrees. The present invention teaches a method for treating a lung comprising fluidly connecting the lung with an extrapleural airway. U.S. Patent No. 6,488,673 teaches a method of increasing gas exchange performed by the lung by damaging the area within the lung and does not discuss affecting the extrapleural airway or outside the lung.

Claim 1 of the '673 patent recites damaging lung cells with an apparatus to cause fibrosis to stiffen the airway so as to increase gas exchange performed by the lung. Claim 8 of the '673 patent recites damaging tissue in the lung with the apparatus to increase gas exchange performed by the lung. Claim 14 of the '673 patent recites causing trauma to tissue with the apparatus to cause fibrosis to stiffen the airway. Claim 15 of the ;673 patent recites destroying airway smooth muscle tone with the apparatus to increase gas exchange performed by the lung. Claim 17 of the '673 patent recites damaging airway tissue with the apparatus to thicken a wall of the airway. Clearly, none of these claims discuss fluidly connecting the lung with an extrapleural airway.

Accordingly, applicant submits that the Office Action fails to establish a proper prima facie case of obviousness. Namely, the requirements of applicant's claims are not found by the reference applied. Furthermore, the Office Action fails to establish a suggestion for modifying the reference to arrive at applicant's claims.

Applicant respectfully requests withdrawal of this rejection.

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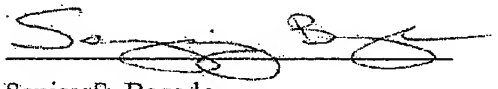
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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